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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,501	09/13/2004	Akihiro Kuroda	016912-0209	6483

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EXAMINER

SOROUGH, LAYLA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/507,501	KURODA, AKIHIRO	
	Examiner	Art Unit	
	Layla Soroush	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09132004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

The Office Action is in response to the Preliminary Amendment filed September 13, 2004. The priority date of March 11, 2002 has been recognized. Claims 1-16 are pending.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claim 2 is objected to because it contains more than one sentence. Periods may not be used elsewhere in the claim except for abbreviations. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "primary particle size" which is considered vague and indefinite. It is suggested that the applicant use the language of "average particle

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size" or "mean particle size" in connection with the water repellent resin powder of the cosmetic composition of the claimed invention.

Claim 15 recites the limitation "the coated portion" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-10, 12, 14-15, and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Ichinohe et al. (US Publication no. 20030082218A1).

Ichinohe et al. teaches a cosmetic material containing silicone-modified wax, unctuous agents, water, compounds with at least one alcoholic hydroxyl group in its molecular structure, macromolecular compounds dissolving or swelling in water, powders and/or coloring agents, surfactants, cross-linked organopolysiloxanes, and silicone resins (see abstract in entirety; also, page 1, paragraph [0004]; page 3, paragraphs [0024-0027 and 0030]; page 4, paragraphs [0039 and 0042]; and page 5, paragraph [0043]). Specifically, the reference teaches in Example 11 the following components of the invention (see page 10; Table entitled "Compact Foundation of Water in Oil Type"): Dimethylpolysiloxane in 24 weight % (non-volatile oil agents, of instant claims 1a and 5). Further, Ichinohe et al. teaches dimethylpolysiloxane and

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methyphenylpolysiloxane are used as silicone oils in the cosmetic composition. The amount of the said components in the cosmetic composition ranges from 1- 98 weight % to total cosmetic material (page 3, left column, lines 23-30 from top and lines 45-50 from top). Polymethylsilsesquioxanes is an organic powder used as a component in the composition, as well (water-repellent resin powders, of instant claims 1b and 6). The amount of the said component in the cosmetic composition ranges from 0.1- 99-weight % to total cosmetic material (page 4, left column, lines 1-15 from top and lines 52-63 from top). Component 5 of Example 11 in the cosmetic composition is a trimethylsiloxysilicate in 1 weight % (oil-soluble silicone resins, of instant claims 1c and 8). Also, it is taught that the amount of the said component in the cosmetic composition can range from 1- 98 weight % to total cosmetic material (page 3, left column, lines 36-37 from top and lines 45-50 from top). Ichinohe et al. teaches a lower alcohol to be used in the composition (volatile solvent, of instant claims 1d and 9). The amount of the said component in the cosmetic composition ranges from 0.1- 98-weight % to total cosmetic material (page 3, left column, lines 1-4 from bottom, and right column, lines 1-4 from top). Also, titanium oxide, zinc oxide, and cerium oxide are inorganic powders taught as components of the cosmetic composition (water-repellent surface treated pigment, of instant claims 1e (in part) and 10). Further, Ichinohe et al. teaches that any powder can be mixed into the composition regardless of shape, size, and structure as long as they have hitherto been used in conventional cosmetic materials. The amount of the said components in the cosmetic composition ranges from 0.1- 99 weight % to total cosmetic material (page 3, right column, last 3 paragraphs in entirety and page 4, left

column, last paragraph in entirety). Additionally, the inorganic and organic powders are treated with general oils, silicone oils, etc, as recited in claim 7 and 12 (see further discussion below (page 4, left column lines 1-10 from bottom of page)). Component 6 of Example 11 in the cosmetic composition is a polyether-modified silicone, as recited in claim 3. Further, Ichinohe et al. teaches the use of any anionic, cationic, nonionic, and amphoteric surfactants as long as they are used in general cosmetics (page 4, right column lines 1-6). Example 11 also includes a 1,3-butylene glycol in 2.0 weight % as component 8 of the composition (polyhydric alcohol, as recited in instant claim 4 (page 3, right column, line 1 from top of page)).

Claims 7 and 12 are product by process claims. It is well settled in patent law that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. See MPEP § 2123. The court in In re Thorpe held, “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In this case, the method of making the composition as claimed does not render structural limitations to the claimed composition. Thus, the processes are not given patentable weight. In claim 7, the formulation of the water-repellent resin powder “in a form of being kneaded with an oil agent, finely crushed by a crusher, or dispersed in water” is not given patentable weight.

Also, in claim 12 the formulation "in a mechanically ground form in advance or at the time of production of the cosmetic product" is not given weight.

Ichinohe et al. do not expressively teach the term "water-runability," as recited in claims 1e (in part) and 14. However, the reference teaches that the composition has a "strong repellency to sweat and water." This is viewed equivalent or similar to the recited property of the cosmetic composition, as recited in claims 1e and 14.

Also, the method of imparting water-runability on the skin or hair, as recited in claim 16, is viewed obvious because the reference teaches the moisture resistant property and its use on the skin or hair (see page 2, left column, last paragraph in entirety). In the examiners view, the "water-runability" property of the claimed cosmetic composition and its use are equivalent to that of the reference composition. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use the cosmetic composition taught in the prior art with the expectation of successfully producing a similar cosmetic composition with the resulting water-runability and usability properties.

Ichinohe et al. does not specifically teach the coated portion having "three or more of protruding portions having a height of 0.2 μm or more per 10 μm -length," as recited in claim 15. However, Ichinohe et al. teaches the composition as claimed and therefore the properties of such a claimed composition are viewed obvious. The cosmetic composition requires the same components and the physical properties of the cosmetic composition will therefore be identical. A physical property is inseparable from its composition and because prior art teaches the cosmetic composition, then the

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properties are also taught by the prior art (In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) See MPEP 2112.01).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichinohe et al. (US Publication no. 20030082218A1), as applied to claims 1, 3-10, 14-15, and 16 as above and further in view of Fukuchi (English translation, JP 01211518 A).

Ichinohe et al. does not teach the use of a highly polymerized silicone but does teach the use of a one-end hydrogensiloxane (see page 6 right column text and structural formula) as a component in the cosmetic composition.

Fukuchi teaches the use of a polysilicone of the general Formula I in a hair cosmetic composition. Formula I comprises R1 representing a methyl group or phenyl group and R2 represents a methyl group or hydroxyl group (n represents integer of 3,000-20,000) (see page 1, right paragraph, structural formula I). The reference teaches that the ingredients provide "luster and silkiness onto the hair," "excellent conditioning effects," and sustains these effects over "relatively long periods" (see English translation page 2, bullet 3 lines 1-4).

Both Ichinohe et al. and Fukuchi teach compositions directed to hair compositions. It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the composition of Ichinohe et al. by adding to the composition the polysilicone of Formula I in Fukuchi. The modification would have been motivated by the teaching in Fukuchi that the polysilicone of Formula I will provide a sustained luster, silkiness, and excellent conditioning effects on the hair. The skilled artisan would have had a reasonable expectation of successfully producing a stable and

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effective hair cosmetic composition with good moisture resistancy and conditioning effects, because both Ichinohe et al. and Fukuchi teach similar formulations (e.g., hair, creams, emulsions comprising volatile oils, etc.).

Claims 11 and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichinohe et al. (US Publication no. 20030082218A1), as applied to claims 1, 3-10, 14 - 15 and 16 as above, and further in view of Hayashi et al. (English translation, JP 2000327948A).

Ichinohe et al. does not teach the water-repellent surface treated pigment coated with silica, alumina, or zirconia, and also does not teach the water-repellent surface treated pigment further subjected to water repellent surface treatment.

However, Hayashi et al. does teach the use of a metal compound powder having a metal compound particle on the surface of the metallic oxide or hydroxide particle in a cosmetic composition (see English translation [0002]). Further, Hayashi et al. teaches the powder coated with organosilane (see page 4/55, heading [Problem to Be Solved], lines 1-13]). Also, the composition is taught to have "outstanding hydrophobic property" (see [0001]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Ichinohe composition by incorporating the water repellent surface treated pigment component as motivated by Hayashi et al., because the latter teaches that the coated metal compounds have good hydrophobic properties and are used in cosmetics. Therefore, the skilled artisan would have had a reasonable expectation that the composition would yield a strong water repellency property.

Conclusion

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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